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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/817,259

04/02/2004

Donald L. Gadberry

A-3099-AL

1789

21378

7590

10/01/2007

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EXAMINER

EREZO, DARWIN P

ART UNIT

PAPER NUMBER

3731

MAIL DATE

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10/01/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/817,259	Applicant(s) GADBERRY ET AL.	
	Examiner Darwin P. Erez	Art Unit 3731	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 July 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The applicant noted that claim 4 was not treated on the merits and thus, the subject matter of the claim was incorporated into the independent claim 1. Since the examiner erred in treating claim 4 on the merits, a new grounds of rejection is provided in this non-final Office action.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 14-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
4. The new independent claim 14 recites the limitation of the pad having a first portion extending from the rib along the second planar surface and a second portion extending from the outer surface of the housing adjacent to the rib to the first portion of the pad, the second portion of the pad having a width smaller than a width of the first portion of the pad. The written description does not provide support at all for the pad having a first portion and a second portion and the second portion having a width smaller than the width of the first pad. If it is argued that the drawings provide support

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for the new limitation, it is noted that the written description does not state the drawings are drawn to scale. Moreover, the written description does not provide any criticality or support for the pad having multiple portions.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 14, the applicant recites the limitation of: the pad having a first portion extending from the rib along the second planar surface and a second portion extending from the outer surface of the housing adjacent to the rib to the first portion of the pad, the second portion of the pad having a width smaller than a width of the first portion of the pad. It is unclear from this limitation as to how the second portion has a width smaller than the first portion because the dimension of the first portion is not clearly defined. It merely states that the first portion extends from the rib but does not state where it extends to. It is also unclear as to where the second portion is located (via orientation) in the pad.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

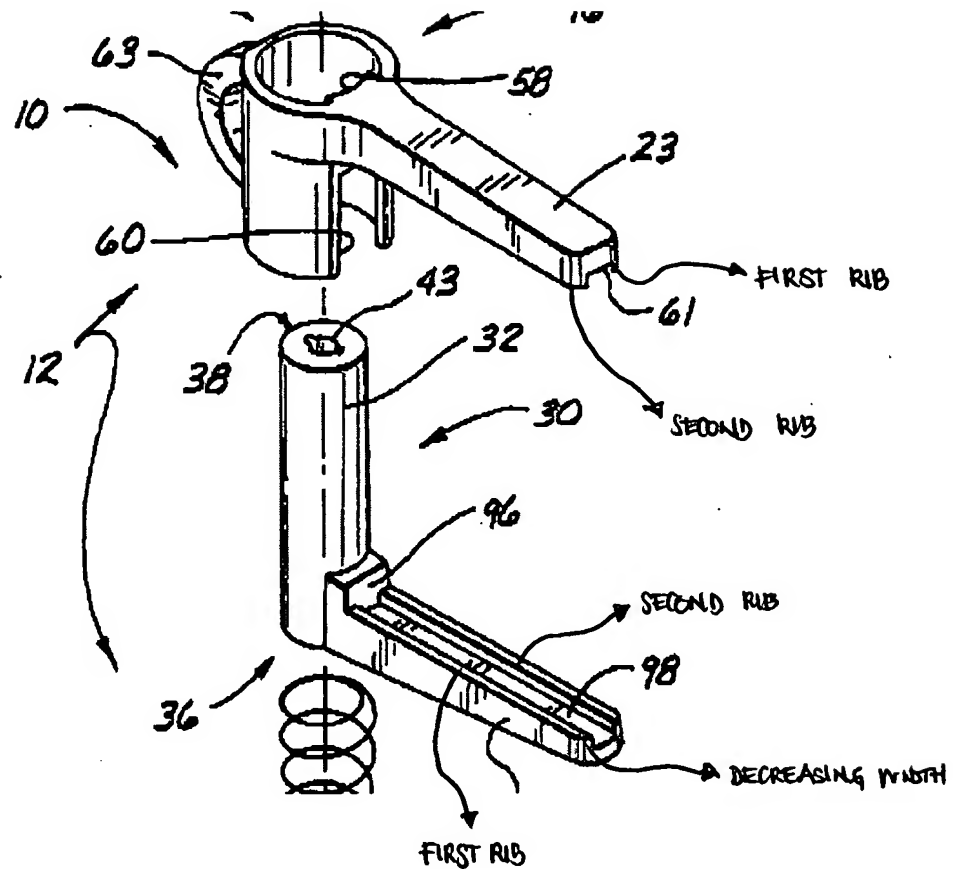
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 1-9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,653,720 to Johnson and in view of US 6,802,848 to Anderson et al.

Johnson discloses a surgical clip comprising a housing having an outer surface and an inner and outer member; a first jaw **34** and a second jaw **23** extending longitudinally from the housing in an opposing relationship with each other and each defining an inner surface; resilient pads **110,112** carried by the first and second jaws and defining a cavity with the outer surface of the housing; two ribs extending longitudinally from the housing and across the cavity (see figure below); wherein pad **112** separates the two ribs of the second jaw; wherein pad **112** covers the inside portion of the ribs; wherein a first rib of the first jaw is offset from the first rib of the second jaw (see figure below); wherein the rib has a measured height next to the inner member of the housing; wherein the ribs are integral with each of the inner and outer members of the housing; wherein device comprises a spring **41**; wherein the ribs have a width that decreases along the jaw (see figure below).



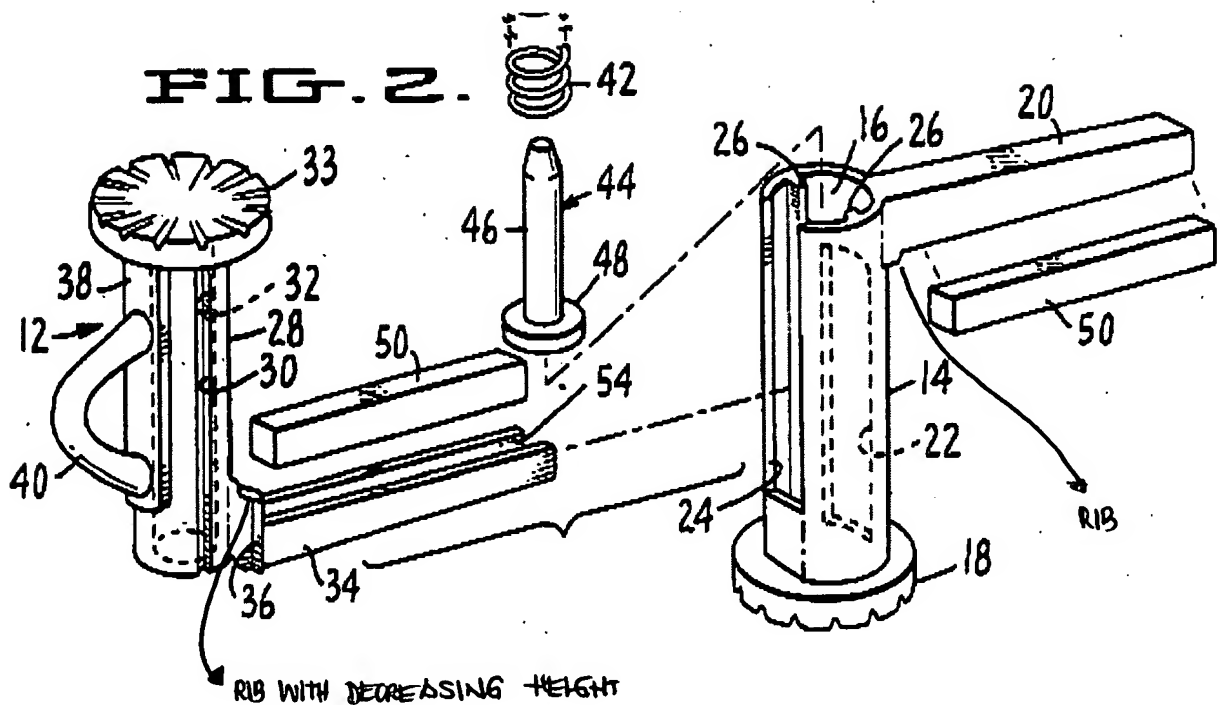
Johnson discloses the resilient pad mounted onto the a jaw and against the ribs but is silent with regards to the method of how the pad is mounted. However, Anderson discloses a similar device, wherein the pad/insert can be mounted on the device via mechanical bonding, molding, adhesives or other well known means (col. 6, lines 27-33). Therefore, it would have been *prima facie* obvious at the time the invention was made to use molding as claimed since Anderson discloses that molding a pad to a jaw is well known in the art.

Johnson also fails to disclose the rib having a decreasing height or decreasing width. However, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the ribs to have

a decreasing height or decreasing width because Applicant has not disclosed that the ribs having a decreasing height or a decreasing width provides any advantage (no criticality). Furthermore, modifying the ribs of Johnson to have a decreasing height or width will not affect the function of the ribs, which is to hold the pads in place.

10. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 4,931,058 to Cooper and in view of US 6,802,848 to Anderson et al.

Cooper discloses a surgical clip adapted for use in holding a suture (see Fig. 4), the clip comprising: a housing having an outer surface (see Fig. 4); a pair of jaws **20,34** extending longitudinally from the housing in an opposing relationship with each other; a resilient pad **50** carried by one of the jaws and defining with the outer surface of the housing a cavity (cavity is shown in Fig. 7, where reference number 54 is directed towards); and at least one rib **36** extending longitudinally of the housing (see figure below) and across the cavity to inhibit passage of the suture into the cavity; wherein the surface of the pad **50** that comes in contact with the groove **54** is viewed as the proximal end wall; wherein one of the jaws has a proximal end and a distal end (as shown in the figure below; and the rib has a height measured perpendicular to the one jaw, which decreases with progressive distal positions along the one jaw; wherein the first rib is attached to the first jaw **34** and the second rib is attached to the second jaw **20** and the pad **50** separates the first rib from the second rib (Fig. 4); wherein a spring **42** disposed in the housing and having properties for biasing the opposing jaws to the closed position; wherein the rib also has a width that decreases along the first jaw (Fig. 6).



Cooper discloses the resilient pad mounted onto the a jaw and against the rib but is silent with regards to the method of how the pad is mounted. However, Anderson discloses a similar device, wherein the pad/insert can be mounted on the device via mechanical bonding, molding, adhesives or other well known means (col. 6, lines 27-33). Therefore, it would have been *prima facie* obvious at the time the invention was made to use molding as claimed since Anderson discloses that molding a pad to a jaw is well known in the art.

Cooper also fails to teach the jaws having more than one rib extending therefrom. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the jaws to have more than one rib, since it has been held that mere duplication of the essential working parts of a device involves only



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routine skill in the art. *In re Harza*, 274 F.2d, 669, 124 USPQ 378 (CCPA 1960).

Furthermore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to arrange the additional ribs to be offset, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection.

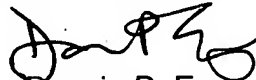
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erez who's telephone number is (571) 272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Darwin P. Erez  
Examiner  
Art Unit 3731

de